

Docket No: 19921/34

#13
N/Secret
2/4/00

Applicant: M. Leveille

Examiner: Philip Tucker

Serial No.: 08/834,061

Art Unit: 1721

Filed: 04/11/97

Title: CALIBRATION MEDIUM FOR WAVELENGTH CALIBRATION
OF U.V. ABSORBANCE DETECTORS AND METHODS FOR
CALIBRATION

EXPRESS MAIL CERTIFICATE

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By

Carmen M. Constantinescu

Assistant Commissioner for Patents
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REPLY TO EXAMINER'S ANSWER

Dear Sir:

This Reply is being submitted in response to the Examiner's Answer dated 11/23/99 which was in response to Applicant's Brief on Appeal dated 7/6/99.

Claims 2-15 and 37 are rejected under 35 USC 102 (e)

Claims 2-15 and 37 are rejected under 35 USC 102 (e) as being anticipated by Orignac et al., Applied Physics Lett., vol. 69, no. 7, pp 895-897. Applicant respectfully disagrees.

The Examiner states that "Orignac teaches a waveguide which comprises an Nd or Er doped sol-gel medium, wherein Erbium nitrate is used as the Er salt ... Applicants intended use as a calibration medium does not distinguish, since applicants claims just

recite a functional capability of the medium. Applicants claim also recite instrumentation which is not part of the claimed medium." (See, Examiner's Answer, page 4).

In citing the particular cases of In re Jones, In re Mod, and In re Lintner, and asserting that the law is "replete" with decisions in which "the mere difference for adding a material to another is not a patentable difference," the Examiner misses the point that the language coming directly from the claims relates to material claim limitations and not an intended use. The Examiner should not continue to ignore these material claim limitations present in the preamble and the body of the current claims, in particular, Claim 37, for this leads to confusion.

It is appreciated that the preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. M.P.E.P. § 2111.02. In order to limit the claim, the preamble must be "essential to point out the invention as defined by the claim." Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In claims directed to articles, which Applicant's Claim 37 is, any phraseology in the preamble that limits the structure of that article must be given weight. In re Stencel, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987).

In the Stencel case, the claim was directed to a driver for setting a joint of a threaded collar. The claim set did not directly include the structure of the collar as part of the claimed article. The preamble did set forth the structure of the collar but the examiner ignored it and failed to attribute any weight to it. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. The court stated that "the framework-the teachings of the prior art- against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." *Id.* at 1073, 828 F.2d at 754.

The case compels an analysis such as that of Kropa and In re Stencel. Applicant in the preamble for Claim 37 does recite limitations that bear upon the calibration medium. For example, just as the driver was employed for setting a joint of a threaded collar in In re Stencel, so to is the calibration medium used for calibrating an optical instrument. Clearly this represents a further limitation (not merely an intended use), placed upon the calibration medium, as was the case for the driver in In re Stencel.

Further limitations are recited in the elements characterizing the optical instrument. In fact, in the sol-gel glass monolith element of Claim 37 under appeal, there is a direct reference made to a "sensor assembly" which is an integral part of the optical instrument recited in the preamble. Thus there is a direct reference made in the body of the claim to the optical instrument recited in the preamble to the claim. This direct reference is indicative of the preamble "breathing life and meaning into the claim." The Examiner points out on page 4 of his Answer, "[i]t is noted that the claims which recite the instrumentation as part of the claimed subject matter have been allowed by the examiner" To paraphrase the In re Stencel Court, 'the framework-the teachings of

the prior art-against which patentability is measured is not all calibration medium broadly, but calibration medium suitable for use in combination with an optical instrument, for the claims are so limited.' In conclusion, Orignac et al. does not defeat the present application for lack of novelty, it neither teaches nor suggests the use of a calibration medium in combination with an optical instrument. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claims 2-4, 6, 7, 9-15 and 37 are rejected under 35 USC 102 (b)

Claims 2-4, 6, 7, 9-15 and 37 are rejected under 35 USC 102 (b) as being anticipated by Xu et al., Journal of Non-Crystalline Solids, vol.194, pp 235-240 (1996). Applicants respectfully disagree.

Again, the Examiner maintains that "Xu teaches an optical device comprising a laser, spectrophotometer and photomultiplier which utilizes a doped sol-gel medium comprising Erbium nitrate ... Applicants intended use as a calibration medium does not distinguish ... Applicants claim also recites instrumentation which is not part of the claim."

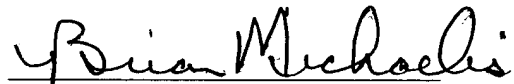
The law is clear that the preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. M.P.E.P. § 2111.02. In order to limit the claim, the preamble must be "essential to point out the invention as defined by the claim." Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In claims directed to articles, such as Applicant's Claim 37, any phraseology in the preamble that limits the structure of that article must be given weight. In re Stencel, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987).

As asserted hereinbefore, the analysis of Kropa and In re Stencel should be applied in the present case. Applicant in the preamble for Claim 37 recites limitations that bear upon the calibration medium. For example, just as the driver was employed for setting a joint of a threaded collar in In re Stencel, so to is the calibration medium used for calibrating an optical instrument. Clearly this represents a further limitation placed upon the calibration medium, as was the case for the driver in In re Stencel. Again, in the present case further limitations are recited in the elements characterizing the optical instrument. In fact, in the sol-gel glass monolith element of Claim 37, there is a direct reference made to a "sensor assembly" which is an integral part of the optical instrument recited in the preamble. There is a direct reference made in the body of the claim to the optical instrument recited in the preamble to Claim 37. This direct reference is indicative of the preamble "breathing life and meaning into the claim."

In conclusion, like Orignac, Xu et al. does not defeat the present application for lack of novelty, it neither teaches nor suggests the use of a calibration medium in a combination requiring an optical instrument such as Applicant discloses and claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of rejections.

Applicant contends that the application is in condition for allowance and respectfully requests that the Examiner reconsider and withdraw all of rejections and allow the application to issue. Given that Claim 37 should be found allowable, the dependent claims depending from Claim 37 should also be allowed.

Respectfully submitted,



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Date: January 24, 2000